

**REMARKS**

Claims 1-48 are pending in the present application. By virtue of this response, claim 11 has been amended, claims 49-53 added, and claims 1-10 and 20-39 have been withdrawn in response to a restriction requirement. Accordingly, claims 11-19 and 40-53 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

**I. Claim Amendments/New Claims**

Claim 11 has been amended to improve the clarity and not in response to a rejection herein. New claims 49-52 have been added. Support for new claims 49-53 may be found, e.g., in paragraph [0045] and Figs. 5a and 5b of the present application. Accordingly, no new matter has been added.

**II. Election/Restriction**

Applicants hereby affirm the election of claims 11-19 and 40-48 drawn to a multilayer article. Applicants expressly reserve their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

**III. Double Patenting Rejection**

Claims 11-19 and 40-48 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,156,415 to Campbell et al. (hereinafter "Campbell").

Applicants respectfully submit that the Examiner has failed to provide a *prima facie* case for obviousness type double patenting. Initially, it is noted that the analysis of obviousness-type double patenting determination parallels the analysis for a 35 U.S.C. § 103(a) obviousness rejection. See, e.g., § MPEP 804, part II, B, 1; *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991). Further, it is well established that there must be some suggestion or motivation to modify the reference to support an

obviousness rejection. MPEP § 2143. In particular, the prior art must suggest the desirability of the claimed invention, and a showing of a suggestion, teaching, or motivation must be clear and particular and based on evidence. MPEP § 2143.01; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

In this instance, the Examiner states that

Although the conflicting claims are not identical, they are not patentable distinct from each other because the present claims differ only in the recitation of a third substrate and that the substrates contain at least one hole for the adherent to pass through. Since the patented claim 1 includes the language “comprising”, an additional third substrate is obvious to include. In regards to the holes in the substrates, the adherent is the same material, adhered in the same way, it is obvious that Patent ‘415 would have holes since the same materials and structures of the product is the same.

Applicants submit that the proffered motivation for modifying the disclosure of Campbell is insufficient to support a *prima facie* case of obviousness. The Examiner has not identified anything in the prior art that suggests or motivates one skilled in the art to include “a third substrate,” or “at least one hole,” and is merely engaging in hindsight analysis. Specifically, the analysis lacks any evidence of a suggestion or motivation to lead one skilled in the art to modify the reference to meet the features of the present claims based on evidence, e.g., a reference or affidavit of the Examiner’s personal knowledge. See, 37 CFR 1.104(d) (1) and (2). The mere fact that a reference can be combined or modified is not sufficient to establish *prima facie* obviousness unless the prior art also suggest the desirability of the combination. MPEP § 2143.01. Accordingly, the Examiner has failed to point to any evidence suggesting the desirability of a modification to meet the features of the present claims and the rejection should be withdrawn.

Applicants further note that the term “comprising” signifies that the claim covers a multilayer article that includes at least the recited features. The term “comprising,” however, does not suggest or provide a motivation for any particular additional feature(s).

#### **IV. Claim Rejections under 35 U.S.C. § 102(e)**

Claims 11, 12, 14-19, 40, 41, and 43-48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,156,415 to Campbell et al. (hereinafter “Campbell”).

The Examiner states “Campbell teaches a system comprising a first and second substrate having an adherent between the substrates, also showing a third substrate in Figures 2-5.” Applicants respectfully disagree and submit that Campbell fails to disclose a multilayer optical article including a first substrate, a second substrate, and a third substrate, and having a first layer of partially cured adherent disposed between the first substrate and second substrate, and a second layer of partially cured adherent disposed between the second surface and the third surface, as recited in claims 11 and 40.

Specifically, Applicants submit that Figures 2-5 of Campbell fail to disclose the features of independent claims 11 and 40. For instance, Figure 2 shows two paths through a multilayer article including three layers 10, 12, and 14, but does not disclose a multilayer article including a first, second, and third substrate with a first and second layer of adherent disposed between the first, second, and third substrates as presently claimed. Figures 3A, 3B, 4A, and 4B illustrate exemplary holders for holding substrates, and Figure 5 illustrates a holder 30 with a substrate 32 and adherent 34. (see, e.g., col. 3, line 66 – col. 4, line 6 and col. 8, lines 25-38). Therefore, Figures 2-5 of Campbell do not disclose an optical article including a first substrate, a second substrate, and a third substrate having a first and second layer of adherent disposed between the substrates.

Further, in regards to claim 40, and specifically the features “wherein the first surface is optically reflective,” Applicants submit the Examiner has improperly relied upon inherency in support of the rejection. Reliance on inherency when the reference is silent about the asserted inherent characteristic requires a rationale or evidence showing inherency. MPEP § 2112. The rationale or evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Inherency, however, may not be established by probabilities or possibilities.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (emphasis added); MPEP §§ 2112, 2131.01.

The Examiner states, “[t]he same materials are taught; therefore the optically reflective property is inherent (claim 40). See col. 3, lines 55-60, col. 4, lines 25-68, col. 11, lines 30-50 and col. 13, line 55-col. 14, line 14.” The cited portions of Campbell, however, fail to disclose a reflective surface or reflective material or layer such that the first surface is optically reflective. In contrast, the present application describes that a “reflective material formed on the substrate.... may be aluminum, gold, copper, or any other suitable material.” (see, e.g., paragraph [0045]). Thus, the same materials are not taught and the rejection should be withdrawn.

Accordingly, for at least the reasons above, Campbell fails to disclose all the features of the present claims and the rejection should be withdrawn.

#### **V. Claim Rejections under 35 U.S.C. § 103**

A. Claims 11-12, 14-19, 40-41, and 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,393,365 to Smith (hereinafter “Smith”) in view of U.S. Patent No. 6,075,626 to Mizutani et al. (hereinafter “Mizutani”).

##### **1. Claims 11, 12, and 14-19**

Applicants respectfully disagree with the rejection and submit the Examiner has failed to present a *prima facie* case of obviousness on several grounds detailed herein.

Initially, Applicants submit that the Examiner has failed to establish a teaching, suggestion, or motivation to combine the teachings of Smith and Mizutani. The Examiner states that “[i]t would have been obvious to one of ordinary skill in the art to modify the laminate of Smith to include a photopolymer adherent since Mizutani teaches its usefulness with holograms.” (see, page 6, paragraph 14 of the Office Action). It is clear that the Examiner is engaging in hindsight analysis. The assertion that Mizutani teaches the usefulness of photopolymer adherents in holograms, even if

true, does not provide any teaching, suggestion, or motivation to combine the reference teachings, let alone to modify Smith to meet the features of the present claims, because Smith does not disclose a holographic article or system. That is, the Examiner has not identified anything that would suggest why one of ordinary skill in the art would combine the references, let alone combine and modify the references, to meet the specific features of the present claims. Therefore, the rejection should be withdrawn because the Examiner has failed to establish a suggestion, teaching, or motivation in the prior art such as a specific understanding or technical principle that would have suggested the combination to meet claims 1, 13, or 30. See, *In re Rouffet*, 149 F.3d at 1350, 1357 (Fed. Cir. 1998); MPEP §§ 2142, 2143.01.

Applicants further submit that neither Smith nor Mizutani disclose or suggest modifying Smith to include a photopolymer as an adherent. The Examiner cites to col. 1, lines 25-45 of Mizutani as disclosing a photopolymer. Mizutani discloses that a hologram element, which may include a photopolymer, is attached to a plate using an optical adhesive. Col. 1, lines 39-48. Mizutani, however, fails to disclose or suggest using a photopolymer as an adherent. Accordingly, the combination of Smith and Mizutani do not disclose or suggest a multilayer article having an adherent including a photopolymer as recited in the present claims.

Additionally, Applicants submit that Smith is non-analogous art and is therefore improperly combined with Mizutani. To rely on a reference under 35 U.S.C. § 103(a), a reference must be analogous prior art. MPEP § 2141.01(a). In particular, “the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” *In re Oetiker*, 977 F.2d, 1443, 1446 (Fed. Cir. 1992). As further explained in *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992), a reference is reasonably pertinent if it “logically would have commended itself to an inventor’s attention in considering his problem.”

In the present instance it is clear that a decorative relief pattern provided on glass/plastic laminate as taught by Smith and in the field of decorative surface patterns is not in the same field of Applicants endeavor regarding multilayer optical articles and holographic storage media (e.g., compare Smith, col. 1, lines 6-7 and 46-61 with pages 5-6, paragraphs [0011] and [0014] of the

present application). It is further evident that Smith is not reasonably pertinent to the problem addressed by the present application regarding physical thickness uniformity and improved optical properties, for example (see, e.g., pages 1-4 of the present application). In contrast, the problem addressed in Smith includes “a simplified inexpensive process for embossing or patterning glass/plastic laminates which is adaptable to providing almost a limitless number of different patterns,” which “will find utility in the automobile industry, in the transportation industry...building industry...interior decorating...furniture industry...in various forms of illumination, in making aquariums, mirrors, shower doors, and in any situation where such decorated glass might be desired.” (Smith, col. 1, lines 30-33; col. 4, lines 10-16). A reference to a process for producing a glass/plastic laminate having a decorative textured pattern would not have logically commended itself to an inventor’s attention dealing with a multilayer optical article of improved physical thickness uniformity and improved optical properties. Therefore, Smith is non-analogous art and is inappropriate under an obviousness rejection.

For at least the above reasons, the Applicants request the rejections to claims 11, 12, and 14-19 be withdrawn.

2. Claims 40, 41, and 43-48

Claim 40 should be allowable for at least similar reasons discussed above with regard to claim 11. In particular, claim 40 includes similar features discussed above and the combination of Smith and Mizutani fail to disclose or suggest the features for similar reasons.

Additionally, Applicants submit that the combination of Smith and Mizutani fail to disclose or suggest an optical article including “a first substrate with a first and second surface, wherein the first surface is optically reflective.” The Examiner states with regard to Smith that “[t]he same materials are taught; therefore the optically reflective property is inherent (claim 40).” (page 5, paragraph 11 of the Office action; emphasis added).

Applicants submit that the rejection improperly relies on inherency to meet the features of the present claims and should therefore be withdrawn. Reliance on inherency when the reference is

silent about the asserted inherent characteristic requires a rationale or evidence showing inherency. MPEP § 2112. The rationale or evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (emphasis added); MPEP §§ 2112, 2131.01.

In this instance, the Examiner merely states that “the same materials art taught; therefore the optically reflective property is inherent.” Applicants disagree. Initially, Smith fails to disclose or suggest a substrate wherein the “first surface is optically reflective.” Further, Smith does not disclose or suggest the same materials as the present application. For example, the present application describes that a “reflective material formed on the substrate.... may be aluminum, gold, copper, or any other suitable material.” (see, e.g., paragraph [0045]). Smith does not disclose or suggest the same materials. Accordingly, an optically reflective property is not inherently disclosed by Smith and the rejection should be withdrawn.

B. Claims 13 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,393,365 to Smith in view of U.S. Patent No. 6,075,626 to Mizutani et al. and further in view of U.S. Patent No. 5,556,709 to Kato et al.

Claims 13 and 42 depend from claims 11 and 40 and should be allowable for at least similar reasons discussed above. The addition of Kato does not cure the deficiencies discussed above, nor is it alleged to.

**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 495812001900. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: November 24, 2003

Respectfully submitted,

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